

2833

402-038-19IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy	:	Examiner B. Hammond
Serial No. 08/951,276	:	Group Art Unit: 2833
Filed: October 16, 1997	:	
Title: Retractable Receptacle For Furniture	:	
	:	
	:	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Box DAC
Office of Petitions

REQUEST FOR RECONSIDERATION OF DECISION
ON PETITION BY TECHNOLOGY CENTER DIRECTOR

The above identified Applicant, by and through his undersigned attorney, hereby requests review of the Decision On Petition dated November 19, 2003 (copy enclosed), by the Director of Technology Center 2800.

On April 15, 2003, a Petition to Commissioner Under 35 CFR 1.181 (copy enclosed) was filed requesting that the decision in the Official Action dated March 7, 2003, to re-open prosecution on the merits after appeal, be vacated. As more fully discussed

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Mark P. Stone
MARK P. STONE
Reg. No. 27,954

12/9/03
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in the Petition filed on April 15, 2003, Applicant filed a Notice of Appeal in response to a final rejection by the Primary Examiner dated August 31, 1999, raising both prior art and formal grounds of rejection. Applicant's Appeal Brief addressed both the prior art and the formal grounds of rejection, and the Examiner's Answer expressly withdrew the prior art grounds of rejection. The Board of Patent Appeals And Interferences reversed the formal grounds of rejection but the Examiner re-opened prosecution on the merits raising prior art rejections based upon the same prior art references applied in the final rejection dated August 31, 1999.

In the Petition filed on April 15, 2003, Applicant argued that the re-opening of the prosecution on the merits after appeal to reject the appealed claims on prior art known to and applied by the Examiner prior to the Appeal, where all prior art rejections made prior to the filing of the appeal were expressly withdrawn by the Examiner, violates 37 CFR 1.198 because 1). the grounds of prior art rejection raised by the Primary Examiner in the reopened prosecution have already been adjudicated by the Board (by default), and 2). because the Primary Examiner has failed to show good cause why prosecution should now be reopened to reject claims over identical prior art known to the Examiner prior to the filing of the appeal and expressly withdrawn by the Examiner prior to decision by the Board, as are more fully addressed at Section III, starting at page 3 of Applicant's Petition filed on April 15, 2003.

The Decision on Petition dated November 19, 2003, states that the Board only adjudicated the formal grounds of rejection, and never adjudicated the rejection of the claims over the prior art. However, this occurred only because the Examiner expressly withdrew the prior art rejections in the Examiner's Answer prior to the decision on appeal, but allowed the appeal to proceed based only on the formal grounds of rejection.

The Decision On Petition states "...no where in the record is it indicated that the claims were allowable over the prior art of record." Applicant respectfully disagrees. The fact that the Examiner withdrew all prior art rejections in the Examiner's Answer (in response to the arguments advanced by Applicant in the Appeal Brief that the claims are allowable over the prior art applied in the final action), and that the Examiner allowed the appeal to proceed based only on the formal grounds of rejection is, at the least, an implicit admission that the Examiner considered the appealed claims to be allowable over the prior art of record.

The Decision On Petition dated November 19, 2003, also states that "...the new grounds of rejection under 35 U.S.C. Section 103 show sufficient cause to warrant the reopening of prosecution". However, the Decision On Petition fails to provide any explanation why the new grounds of rejection, which are based upon the identical prior art references cited and applied in the Final Action dated August 31, 1999, were not made by the Examiner

prior to Decision by the Board on Appeal, particularly when the Examiner expressly withdrew all prior art rejections in the Final Action but allowed the Appeal to proceed based only on the formal grounds of rejection.

Applicant respectfully submits, for the reasons addressed in the Petition filed on April 15, 2003, that the reopening of prosecution on the merits after decision by the Board for the purpose of raising prior art rejections based on the identical prior art references applied by the Examiner prior to the Appeal, which were expressly withdrawn by the Examiner prior to the decision by the Board, violates 37 CFR 1.198.

Applicant respectfully requests reconsideration and reversal of the Decision On Petition, dated November 19, 2003, denying Applicant's Petition filed on April 15, 2003.

Enclosed are copies of Petition filed on April 15, 2003, and the Decision On Petition dated November 19, 2003.

Also enclosed is a notice of Change Of Attorney's Correspondence Address. Please forward all further

correspondence regarding this patent application to the address indicated on the enclosed notice.

Respectfully submitted,



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In re Application of:

David G. McCarthy
Serial No.: 08/951,276
Filed: October 16, 1997
Attorney Docket No.: 402-038-19

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.181, filed on April 15, 2003.

The petition is DENIED.

The petitioner requests that the decision in the Official Action dated March 7, 2003 be vacated.

A review of the record indicates that the Board of Patent Appeals and Interferences (BPAI) only adjudicated the matter of the rejection under 35 USC §112, 1st paragraph. The BPAI never adjudicated the rejection of the claims over prior art.

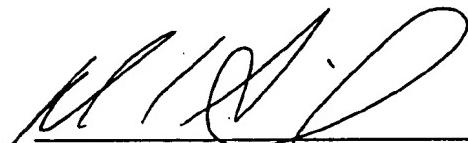
While the art rejection was withdrawn prior to the decision by the BPAI, no where in the record is it indicated that the claims were allowable over the prior art of record.

The Examiner has reopened prosecution and properly rejected the claims on new grounds, albeit using the same prior art, as pointed out by the petitioner. 37 CFR 1.198 states "Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of 37 CFR 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown." It is our contention that the new grounds of rejection under 35 USC §103 show sufficient cause to warrant the reopening of prosecution.

Accordingly, the petition is denied.

Inquiries regarding this decision should be directed to Paula Bradley at (703) 308-2319.

The case will be forwarded to Examiner Hammond.



Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components